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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,998	10/19/2001	Reinhard Lorenz	IN-12095	9873

7590 09/09/2004
BASF Corporation
1419 Biddle Avenue
Wyandotte, MI 48192-3736

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,998	Applicant(s) LORENZ ET AL.	
	Examiner Rabon Sergent	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1711

1. Applicants' amendment of June 21, 2004 is improper, because canceled claims 9-16 are indicated as being "Withdrawn". Within page 3 of the entered amendment of February 9, 2004, claims 9-16 were canceled by applicants.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/27236 or Televantos et al. ('323).

Televantos et al. and WO 97/27236 disclose the production of polyether polyols and polyurethanes, including polyurethane foams, wherein, in the production of a polyether polyol, a multimetal cyanide catalyst is used in the oxyalkylation of an active hydrogen group containing initiator. The references further disclose that it is desirable that the initiator is an oligomer derived from the conventional oxyalkylation of monomeric initiators, and the references further disclose that the oxyalkylation of the monomeric initiators may be base catalyzed. Disclosed basic catalysts are sodium or potassium hydroxide. See column 7, lines 5-18 within Televantos et al. and page 12, lines 9-27 within WO 97/27236. The position is taken that these disclosures anticipate applicants' claims, because the basic catalyzed oligomeric initiators inherently contain a quantity of metal salts, corresponding to those claimed, which are present at the time of the subsequent multimetal cyanide catalyzed reaction. The inherently present salts stem from the neutralization of the basic catalysts with acids. It was known at the time of invention that basic catalysts within polyols are neutralized with acids to deactivate the catalysts and that the

Art Unit: 1711


presence of strongly basic catalysts prevent the initiator's further use with multimetal cyanide catalysts. See page 12, line 12 within WO 97/27236 and the teachings within Parsons et al. ('749) at column 1, lines 57+ and Christen et al. ('548) at column 1, lines 15+ (These additional references have been relied upon only to support the position that the conventional basic catalyzed oxyalkylation reactions of WO 97/27236 or Televantos et al. employed the aforementioned neutralization step).

4. Despite applicants' response, the position is maintained that the examiner has set forth a reasonable rationale for holding that the claimed metal salts are present within the polyols of the relied upon references. Applicants have not provided any evidence to establish that the examiners' position is incorrect.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER